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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,345	09/08/2003	Andreas Natsch	102790-150	1644

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EXAMINER

BADIO, BARBARA P

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/657,345

**Applicant(s)**

NATSCH, ANDREAS

**Examiner**

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/928,630.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/8/03 &amp; 2/18/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

**First Office Action on the Merits**

***Priority***

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/928,630, filed August 13, 2001. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is

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considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims recite a method of providing antibacterial activity to a patient by “administering” the claimed compounds. The term “administering” encompasses all known routes of administration, i.e., oral, intravenous, intramuscular, etc. However, the present specification only discloses the utilization of the claimed compounds in “personal care products”. Therefore, the instant claims contain subject matter not described in the present specification in a way to reasonably convey to the skilled artisan in the art that applicant, at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Darsow (US 5,874,648).

Darsow teaches the production of isocamphylcyclohexanols such as 2-hydroxy-1-(5-isocamphyl)cyclohexane, 3-hydroxy-1-(5-isocamphyl)cyclohexane and 4-hydroxy-1-(5-isocamphyl)cyclohexane (see the entire article, especially col. 1, lines 10-44; examples 1-3). The reference also teaches the use of said industrial sandalwood perfumes in soaps, cosmetic products and perfume (see especially col. 1, lines 10-15).

The method of use taught by the reference is encompassed by the instant claims.

Note: The genus taught by the reference is such that the skilled artisan in the art would readily envisage each member.

6. Claims 1, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al. (US 4,104,203).

Hall teaches perfume compositions and colognes containing a mixture of odoriferous compounds (see the entire article, especially col. 4, lines 7-59; col. 8, line 51 – col. 9, line 67; examples IV-VII). The reference teaches compounds such as 2-hydroxy-1-(5-isocamphyl)cyclohexane, 3-hydroxy-1-(5-isocamphyl)cyclohexane and 4-hydroxy-1-(5-isocamphyl)cyclohexane (see especially col. 4, lines 45-59). The method of use taught by the reference is encompassed by the instant claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darsow (US 5,874,648), Hall et al. (US 4,104,203) and Robinson et al. (US 5,116,602) in combination.

Darsow teaches the production of isocamphylcyclohexanols such as 2-hydroxy-1-(5-isocamphyl)cyclohexane, 3-hydroxy-1-(5-isocamphyl)cyclohexane and 4-hydroxy-1-(5-isocamphyl)cyclohexane (see the entire article, especially col. 1, lines 10-44; examples 1-3). The reference also teaches the use of said industrial sandalwood perfumes in soaps, cosmetic products and perfume (see especially col. 1, lines 10-15).

Hall teaches perfume compositions and colognes containing a mixture of odoriferous compounds (see the entire article, especially col. 4, lines 7-59; col. 8, line 51 – col. 9, line 67; examples IV-VII). The reference teaches compounds such as 2-hydroxy-1-(5-isocamphyl)cyclohexane, 3-hydroxy-1-(5-isocamphyl)cyclohexane and 4-hydroxy-1-(5-isocamphyl)cyclohexane (see especially col. 4, lines 45-59).

The instant claims differ from the above-cited references by reciting additional compounds not exemplified by the references. For example, claims 2 and 4 recite the 2-methoxy derivatives of the exemplified prior art compounds.

Claims 5, 6 and 8-10 differ from the reference by reciting incorporation of specific amounts of the compound into perfume.

Claims 7, 10 and 17 differ from the reference by reciting the addition of farnesol.

Claim 11 differ from the reference by reciting additional ingredients.

However, (a) the genus taught by the Darsow includes said 2-methoxy derivatives (see col. 1, lines 25-44, i.e., compounds wherein  $X=\text{OCH}_3$ ); (b) preparation of products as taught by the references using various amounts of the compounds is within the level of skill of the ordinary artisan; (c) farnesol is a known bacteriostatic agent used in cosmetic products (see Robinson et al., col. 1, lines 53-58) and (d) the references teach the use of the compounds in personal care products such as soaps, cosmetic products and perfume. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the prior art, including those of the instant claims, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole. It is also within the level of skill of the ordinary artisan in the art at the time of the invention to utilize various amounts of the compounds in different cosmetic products etc. as well as to incorporate various ingredients known to be useful in the cosmetic art in the preparation of said products. Based on the level of skill of the ordinary artisan in the art at the time of the invention and the teachings of the prior art, the claimed invention is *prima facie* obvious.


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***Telephone Inquiry***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1617

BB  
May 12, 2006